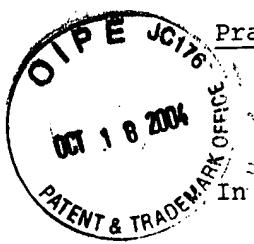


AP 12854
JFW



Practitioner's Docket No. D-7102

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

In re Application of :
:
CHERYL B. LEBEAU, et al :
:
Serial No.: 09/303,632 :
:
Filed: May 3, 1999 :
:
For: DISPOSABLE PLASTIC :
KEYBOARD COVER :

Group Art Unit: 2854

Examiner: L.J. Evanisko

I hereby certify that this
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P. O. Box 1450, Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on Oct. 12, 2004
Arthur D. Yeager

Sir:

This is in response to the Examiner's Answer mailed 08/11/2004.

The applicants expressly state that Gaible et al does not disclose a "pliable plastic film" (P.5, L. 1 Revised Appellant's Brief, emphasis in original). The Examiner does not specifically address the structural differences and limitations of "film" in the claims under consideration. Moreover, Gaible et al does not use or suggest a "film" anywhere in the disclosure. Indeed Gaible et al describes 32a, 32b as plastic "side walls" which terminology does not suggest that the cover of Gaible et al employ "film" as alleged by the Examiner, but only transparent plastic sheets. One cannot assume, nor is it true, that plastic sheets are considered to be "film" as used and disclosed in applicant's claims and specification. Also, note should be taken of the fact that Gaible et al discloses that the container and closure strips may be formed as a single piece extrusion which is not necessarily as the Examiner suggests and unlike anything shown or claimed by applicants.

Applicants argue in the brief and disclose in the claims that the cover of the present invention does not impede operation of a keyboard. Claim 21 recites "said sheet inhibiting any unintentional contact between a keyboard and fingers of an operator while not impeding an operator's ability to manipulate a keyboard in a speedy and accurate manner."

Similar language is recited in claims 32 and 41. Accordingly, the "film" of the present invention is clearly distinguishable from the "side walls" of Gaible et al because there is a specific reason why the applicants require a "film" to cover a keyboard. Contrary to the Examiner's assertion, there is no basis in the Gaible et al disclosure for the proposition that the "flexible bag material" is in fact capable of "permitting a user to depress keys of a keyboard", nor is it inherent from the Gaible et al disclosed invention.

In summary, the pliable plastic film of the present invention has a structure feature necessary for the use of the cover over a keyboard and still allow the unimpeded use of the keyboard. Gaible et al does not provide "all of the structural elements" of the present cover as argued by the Examiner.

The general view of a preamble being treated as a limitation in a claim is the rule that the language used must give "life and meaning" to the claim. See Jansen v. Rexall Sundown, Inc., 342 F.3d 1329, 68 USPQ 2d 1154 (Fed. Cir. 2003) citing Kropa v. Robie, 187 F.2d 150, 88 USPQ 478 (CCPA 1951). The Court in Jansen also stated:

"The preamble is therefore not merely a statement of effect that may or may not be desired or appreciated."

68 USPQ 2d at 1158.

In determining whether the preamble does provide a limitation, the Courts have engaged in an analysis that may be summarized as follows:

"No litmus test defines when a preamble limits claim scope. Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed.Cir. 1989). Whether to treat a preamble as a limitation is a determination 'resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.' Id.; Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (Fed.Cir. (Fed.Cir. 2002)). In general, a preamble limits the claimed invention if it recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1784 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed.Cir. 1999)). Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention. Catalina Mktg., 289 F.3d at 808, 62 USPQ2d at 1785; Bristol-Myers Squibb Co., v. Ben Venue Labs., Inc., 246 F.3d 1368, 1375, 58 USPQ2d 1508, 1513 (Fed.Cir. 2001)."

In re Cruciferous Sprout Litigation, 301 F.3d 1343, 64 USPQ2d 1202 at 1204 (Fed.Cir. 2002).

The recitation in the claims as given hereinabove are an essential structural feature of the present invention.

Also see MPEP 2111 and cases cited therein.

With respect to the other arguments and responses of the Examiner, applicants reiterate the arguments made in the revised Appellant's Brief filed April 26, 2004. Applicants also reiterate the discussion hereinabove regarding the "film" nature of the present cover such that the cover will not impede the use of a covered keyboard.

Applicants maintain that the present cover is not obvious in light of the cited art in any appropriate combination. Accordingly, applicants believe that each of the claims, herein appealed, should be found to be allowable and the Board should reverse the Examiner as to each of such claims.

Respectfully submitted,

Date: Oct. 12, 2004

245-1 East Adams Street
Jacksonville, Florida 32202-3336
Tel.No.: (904) 355-9631
Fax.No.: (904) 355-9632

Arthur G. Yeager
Arthur G. Yeager, Reg.No. 19,892